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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,580	06/07/2001	Kalyan R Anumula	P50868	6381

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EXAMINER
RUSSEL, JEFFREY E

ART UNIT	PAPER NUMBER
1654	

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/857,580	Applicant(s) ANUMULA, KALYAN R	
	Examiner Jeffrey E. Russel	Art Unit 1654	

-- Th MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 June 2001 and 31 August 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *2* is/are allowed.

6)☒ Claim(s) *1 and 3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The abstract of the disclosure is objected to because at line 3, "2-chlorobenzoxazole" is misspelled. Correction is required. See MPEP § 608.01(b).

2. The disclosure is objected to because of the following informalities: At page 1, line 11, "fluorescent" is misspelled. At page 2, lines 19 and 25, "chlorobenzoxazole" is misspelled. At page 2, line 26, "oC" should be re-written as "°C". Appropriate correction is required.

3. The amendment filed August 31, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The sequence listing filed August 31, 2001 constitutes new matter because there are no sequences in this application. The requirement for a sequence listing mailed by the Office on July 5, 2001 was in error because listings and collections of individual amino acids (see Figure 1 and page 4 of the specification) do not constitute sequences which are subject to the sequence disclosure rules. The examiner apologizes for any inconvenience this requirement for a sequence listing may have caused Applicant.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The effective filing date of instant claims 1-3 is deemed to be December 7, 1998, the filing date of provisional application 60/111,250. Instant claims 1-3 are deemed to be entitled under 35 U.S.C. 119(e) to the benefit of the filing date of the provisional application because the provisional application, under the test of 35 U.S.C. 112, first paragraph, discloses the instant claimed invention.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Boesenberg et al. Boesenberg et al teach reacting amino acids with 2-chlorobenzoxazole. See Example 3 and Table 1.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazer et al. Lazer et al teach reacting 2-benzoxazole with amino acids. See column 3, Scheme A, and Tables 1, 1A, and 2.

8. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by the Advani et al article. The Advani et al article teaches reacting amino acids with 2-chlorobenzoxazole. See Table I; page 1695, column 1; and the paragraph bridging pages 1695 and 1696.

9. Claim 2 is allowed. The prior art of record does not teach or suggest detecting amino acids or peptides which have been reacted with 2-chlorobenzoxazole by UV or fluorescence methods. The references discussed above do not perform their reactions for purposes of detection of the amino acids, and do not disclose the reaction products to be UV or fluorescence emitters or absorbers. Accordingly, there is no motivation to detect the reaction products of these references by UV or fluorescence methods.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (703) 308-3975. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback can be reached at (703) 306-3220. The fax number for Art Unit 1654 for formal communications is (703) 305-3014; for informal communications such as proposed amendments, the fax number (703) 746-5175 can be used. The telephone number for the Technology Center 1 receptionist is (703) 308-0196.

Jeffrey E. Russel

Primary Patent Examiner

Art Unit 1654

JRussel

February 20, 2003